

REMARKS

1 The Examiner rejected claims 1, 2, 3, 19 and 20 under 35 U.S.C. § 102(b) as
being anticipated by U.S. Patent No. 6,195,417 to Dans. Applicants respectfully
disagree. However, in an effort to expedite the prosecution of the present matter,
5 applicants have amended claim 1 to specifically claim that the software is operative on
said processor to: a) present an audible message requesting that a callee on the line
terminate the call; b) identify whether or not the call has been terminated after the
audible message is played; and c) classify a telephone number as having been live-
answered if the call was terminated in response to the audible message or classify a
10 telephone number as not live-answered if the call was not terminated in response to the
audible message. This amendment is comprised of limitations from claims 5, 6 and 7.
Accordingly, amended claim 1 does not present new matter not previously considered
or searched by the Examiner.

15 Amended claim 1 specifically requires software that is operative to initiate calls to
the telephone numbers. Dans does not initiate the calls, but rather waits for incoming
calls. Step one depicted in Figure 2 refers to a bank customer calling the system.
Claim 1 further requires the system to specifically request the callee to terminate the
call. Nowhere within Dans does the system make such a request. Finally, the
20 applicants' system categorizes the telephone numbers called as live-answered or not
live answered according to the call being terminated in response to the systems request
that the callee do so. Such classification methodology is not found or suggested within
the prior art.

1 Anticipation under 35 U.S.C. § 102 focuses on the questions of whether or not a
claim reads on the product or process disclosed by a prior art reference, not what the
reference broadly "teaches." Kalman v. Kimberly-Clarke Corp., 713 F.2d 760 (Fed. Cir.
1983). "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every
5 element of the claimed function must be identically shown in a single reference."
Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675 (Fed. Cir. 1988); Verdegaal
Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.
1987) (A claim is anticipated only if each and every element as set forth in the claim is
found, either expressly or inherently described, in a single prior art reference). The
10 differences between the Dans system and the applicants' system, as claimed in claim 1,
are significant. Accordingly, claim 1 is believed to be allowable over the prior art.
Claims 2, 3, 19 and 20 each ultimately depend from claim 1 and are believed to be
allowable for at least the reasons set forth herein with respect to claim 1. Applicants
15 respectfully request the Examiner to reconsider the aforementioned rejections and allow
claims 1-3.

The Examiner rejected claims 5-7, 10-18, 22-24, 27 and 28 under 35 U.S.C. §
103(a) as being unpatentable over the Dans patent, as applied to claim 1, further in
view of U.S. Patent No. 6,850,602 to Chou. Applicants respectfully disagree. Claims 5,
20 6 and 7 have been cancelled, as their limitations have been placed within claim 1. The
Examiner admits that Dans fails to teach a system that requests the callee to terminate
the call as the methodology used to classify a telephone number. However, the
Examiner states that, "using an audible message, Chou is able to terminate the call
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1 either by using the automatic dialing system or a callee." The limitation states that the
system provides an audible message requesting the callee to terminate the call, detects
whether or not the call has been terminated, and then classifies the telephone number
according to whether or not the call was terminated by the callee in response to the
5 message. Nowhere within Chou is such a methodology found or otherwise suggested.
Accordingly, the claimed combination of prior art suggested by the Examiner would not
have rendered claim 5, 6 or 7 obvious. As such, the prior art does not render amended
claim 1 obvious.

10 To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three
basic criteria must be met. First, there must be some suggestion or motivation, either in
the references themselves or in the knowledge generally available to one of ordinary
skill in the art, to modify the reference or to combine reference teachings. Second,
there must be a reasonable expectation of success. Finally, the prior art reference must
15 teach or suggest all the claimed limitations. The teaching or suggestion to make the
claimed combination and the reasonable expectation of success must both be found in
the prior art and not based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20
USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. None of these required elements can
be found in this matter. The claimed software operations and combined elements are
20 not disclosed or otherwise suggested by the prior art. As such, there is no suggestion
or motivation, either in the references themselves or in the knowledge generally
available to one of ordinary skill in the art, to modify the references as claimed by the

1 Examiner. Without all the component characteristics, no success can be expected from
the Examiner's modifications to the prior art systems.

5 The Examiner is not considering the claimed invention or the prior art as a whole.
In determining the difference between the prior art and the claims, the question under
35 U.S.C. § 103 is not whether the differences themselves would have been obvious,
but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc.
v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A prior art
reference and the claimed invention must be considered in their entireties. Distilling an
invention down to the "jist" or "thrust" of an invention disregards the requirement of
10 analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc. v. Garlock,
Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S. 851
(1984). A system that uses software to prompt a callee to terminate the call, detect
whether or not the callee so terminated the call, and then classify the telephone number
15 as being live-answered or not live-answered based on that detection is clearly unique to
the art. No suggestion or motivation can be found within the art for such a system.
Such a simplified system of classification is far less complex, expensive or prone to
error than the prior art classification systems.

20 The prior art must suggest the desirability of the claimed invention. There are
three possible sources for a motivation to combine references: the nature of the
problem to be solved, the teachings of the prior art, and the knowledge of persons of
ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58
(Fed. Cir. 1998) (Stating that the combination of the references taught every element of
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1 the claimed invention, however without a motivation to combine, a rejection based on a
2 *prima facie* case of obviousness was held improper). Obviousness can only be
3 established by combining or modifying the teachings of the prior art to produce the
4 claimed invention where there is some teaching, suggestion or motivation to do so,
5 found either explicitly or implicitly in the references themselves or in the knowledge
6 generally available to one of ordinary skill in the art. The test for an implicit showing is
7 what the combined teachings, knowledge of one of ordinary skill in the art, and the
8 nature of the problem to be solved as a whole would have suggested to those of
9 ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317
10 (Fed. Cir. 2000) (While the control of multiple valves by a single sensor rather than by
11 multiple sensors was a "technologically simple concept," there was no finding "as to the
12 specific understanding or principle within the knowledge of the skilled artisan" that would
13 have provided the motivation to use a single sensor as the system to control more than
14 one valve). Similarly, in this matter, the concept is simple. However, no suggestion or
15 motivation can be found within the references individually or together for the
16 classification of telephone numbers by requesting a callee to terminate the call and then
17 detecting whether or not the call was terminated as requested.

18 Furthermore, the fact that references can be modified is not sufficient to establish
19 *prima facie* obviousness. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).
20 Although a prior art device "may be capable of being modified to run the way the
21 apparatus is claimed, there must be some suggestion or motivation in the reference to
22 do so." Id. Also, "a statement that modifications of the prior art meet the claimed
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1 inventions would have been 'well within the ordinary skill of the art' at the time the
claimed invention was made because the references relied upon teach that all aspects
of the claimed invention were individually known in the art' is not sufficient to establish a
prima facie case of obviousness without some objective reason to combine the
5 teachings of the references." Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. &
Inter. 1993); see also, In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed.
Cir. 2000) (The court reversed an obviousness rejection involving a technologically
simple concept because there was no finding as to the principle or specific
understanding within the knowledge of a skilled artisan that would have motivated the
10 skilled artisan to make the claimed invention).

The Examiner rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being
unpatentable over the Dans patent and further in view of U.S. Patent Application
Publication No. US 20030086541 to Brown et al. Similarly, claims 25 and 26 were
15 rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the
Dans and Suhm et al. patents, as applied to claim 19, and further in view of the Brown
et al. patent application. Claims 8, 9, 25 and 26 each ultimately depend from claim 1
and are believed to be allowable for at least the reasons set forth with respect to claim
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Claims 1-3, 8-20 and 22-28 are believed to be allowable for at least the reasons
set forth herein. The Examiner is respectfully requested to reconsider and allow the
pending claims in this matter.

No fees or extensions of time are believed to be due in connection with this amendment; however, please consider this a request for any additional extension inadvertently omitted, and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,



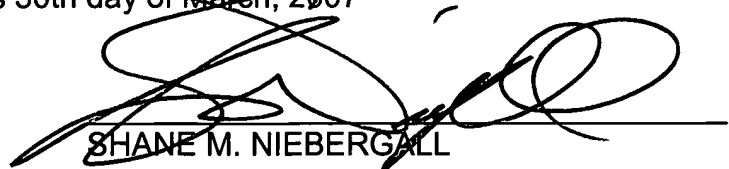
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CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT AFTER FINAL REJECTION for JAMES M. HAYES, ET AL., Serial No. 10/809,736, was mailed by first class mail, postage prepaid, to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30th day of March, 2007



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